

Remarks

This is a continuing prosecution application. In the prior prosecution, claims 7-10 were pending. In Paper No. 20 dated May 9, 2000, the Examiner refused to enter a declaration of the applicant which addressed how the claims of the pending application are entitled to the benefit of the filing date of her 1987 design application. The Examiner indicated that new issues were raised. In response, on May 19, 2000 Applicant filed this continuation prosecution application in order to be sure that this evidence is entered in the record and to obtain the Examiner's ruling thereon. Claims 7-10 are still pending and are not withdrawn nor replaced by the present, newly-added claims. On August 1, 2000, claims 7-10 were rejected.

Information Disclosure

Applicant seasonably makes of record a court ruling of November 2000. This ruling concerns a Proctor & Gamble disposable diaper called a LUVS diaper which had an elastomeric strip, horizontally oriented, at the waistband between the plastic layer and the skin of the wearer. The elastomeric strip was not positioned to touch the skin of the baby but instead was covered by the top sheet.

Applicant understands that this continuation application will proceed under the same serial number as previously used. As such, applicant considers that all of the art previously made of record is still of record in this continuation prosecution and will be listed as having been considered. If this is not the case, the Examiner is respectfully requested to notify the undersigned thereof.

In a deposition of the inventor of May 25, 2000, one defendant requested that Mrs. Tracy make of record the relevant parts of the forthcoming transcript. That document is also enclosed. Also enclosed is the transcript of the deposition of Proctor & Gamble.

Additional Claims

Applicant's filing of a continuation application unencumbers the application from the strictures of the final rejection that was previously entered and gives applicant the opportunity to add additional claims to round out the protection to which she is entitled. The Examiner will appreciate that the new independent claims avoid many of the issues that arose in the earlier prosecution. Applicant earnestly hopes that these matters can be resolved without appeal, as the last appeal (which was successful) consumed three years of time.

Applicant has added new claims 11-40, including three new independent claims. The new independent claims are clearly entitled to the 1987 priority date because the 1987 design application disclosed a disposable diaper having added a horizontally-oriented strip at the waistband, distinct from the other parts of the diaper, adjacent to the plastic edge of the diaper, positioned between that plastic edge and the diaper-wearer at a location to touch the skin of the wearer. Whether the preferred embodiment also wrapped over the plastic edge so as to isolate it is merely a detail of the preferred embodiment that is subsumed in the broader aspects of the invention which are claimed herein. It also had such strip set the legholes.

The Examiner will appreciate that new claims 31-40 follow claims 11-20 but concern the padding at the leg hole rather than the waistband. The 1987 design application also clearly disclosed the addition of a strip at each of the legholes.

The Office Action of August 1, 2000 appears to repeat many of the prior issues. Answering Paragraph 1, the amendment to the specification adds the prefix "07/" to the two serial numbers. Thus, this paragraph of the Office Action has now been complied with.

Paragraphs 2-6 reject independent claims 7 and 8 over Foreman U.S. Patent 4,816,025 as being completely anticipated. Tracy traverses the assertion in Paragraph 4 that Foreman discloses a soft padding member located along a waistband portion adjacent to the outer layer edge.

The evidence of record includes the Declaration of Rhonda Tracy dated January 28, 1999, the second Declaration of Rhonda Tracy dated April 18, 2000, and the reference itself. In the Amendment mailed January 29, 1999, the undersigned explained that claim 7 requires a soft padding member which must include a material formed from a soft substance. We explained that Foreman has second barrier cuffs 262 (which the examiner specifically cites). These are part of the barrier cuffs which trap exudate from the baby or other diaper wearer. These barrier cuffs form a pocket. As explained in Amendment B, to the extent that the Foreman patent refers to a soft edge 266, this is merely because the end of the barrier cuff is looped back upon itself to form a tunnel. The flap that is in the waistband region is not said to include any soft padding material, we submit.

In Paragraph 8-11, the examiner rejects claim 7 as obvious over Foreman in view of Lindquist U.S. Patent 3,572,342. This rejection is traversed. The examiner relies on Lindquist which includes elements 37 and 38 made of foam along portions of a diaper at which the seepage of fluids is not desired.

However, as stated in Amendment B, this combination also does not render the subject matter of claim 7 obvious. The Lindquist diaper includes sealing strips, 37, 38 which extend laterally across the diaper to confine the area of wetness, hopefully allowing another part of the diaper to remain dry. Applicant finds no disclosure in Lindquist of using such strips adjacent to the actual waist edge, as required by one of the features of claim 7, or of using the strips for softening the effect of an edge of a plastic layer in a diaper. The examiner cannot arbitrarily combine citations to meet the features of a claim for purposes of a rejection under Section 103. There must be some suggestion in the field of knowledge to combine the various elements as asserted by the examiner. The only assertion by the examiner in this regard appears at Col. 11 wherein the examiner asserts that it would have been obvious to provide the "upper surface of end cuffs 262 of Foreman with padding elements made of foam in order to retard fluid. See 1:15-20." This appears to be an arbitrary substitution by the examiner. Indeed, the examiner now seems to conflate the two different teachings of these two

different references. Foreman concerns exudate guards, and the examiner arbitrarily would provide a foam padding on top of the exudate guards to control wetness. There is no suggestion, we submit, in either Foreman or Lindquist for combining exudate guards with these foam or other sealing strips of Lindquist. It certainly does not appear that Foreman requires the use of two different types of guards. Accordingly, this basis of rejection is traversed.

In Paragraph 12, claim 7-10 are rejected as anticipated by McConnell et al. 3,461,872 or as obvious thereover.

In response, McConnell appears to be what has been referred to as “rubber pants.” It is not a disposable diaper but instead is a “diaper retaining garment.” One places a disposable diaper in the McConnell garment so that it is “in position adjacent the perineal region of a wearer.” Col. 1, lns 22-23. The examiner specifically points to element 22 in McConnell.

However, as already announced by the PTO Board of Patent Appeals and Interferences in the opinion that was already made of record in this prosecution, McConnell is of no help in remedying the deficiencies of the prior art. McConnell does not disclose a diaper including a plastic layer extending to the edge of the diaper and including a plastic edge at the edge of the diaper at a waistband. This garment includes perimeter bands along edges 11, 12, 18 and 19. There are snap fasteners between each of these four edge bands. Reference is made to an elasticized strip 21 which as seen in Fig. 2 is present at these outer bands. However, as plainly can be seen in Fig. 2, those bands do not form an entire layer of material. Claim 7 at line 8 specifies “a plastic layer having an edge at the edge of the diaper.” The examiner points to no such structure in McConnell. Claim 8 specifies “at least two body-portion layers including... a plastic layer having an edge at the edge of the diaper.” Claim 8, lns. 7-8. (The examiner may note a correction of a typographical error in claim 8 wherein the word “liquid” is changed to –layer–.) The undersigned therefore respectfully traverses the rejection based on McConnell, which clearly is deficient.

In Paragraphs 18, 19, and 20, the examiner raises non-statutory double patenting rejections. The applicant has submitted terminal disclaimers and already paid at least one disclaimer fee. One terminal disclaimer is dated April 23, 1999 and is filed in this prosecution having Serial No. 09/107,643. This terminal disclaimer concerns commonly owned U.S. Patent 5,064,421. Another terminal disclaimer, signed by the applicant herself, was dated April 18, 2000 and filed in this Serial No. 09/107,643. It also concerned U.S. Patent 5,064,421. In light thereof, it is wholly unclear how the examiner can reject claims for double patenting over U.S. Patent 5,064,421. The argument that the currently pending claims would improperly extend the right to exclude already granted in the patent makes no sense when that term has been disclaimed already. Nevertheless, the examiner has already conceded that a timely filed terminal disclaimer may be used to overcome this rejection. Office Action at pg. 6.

In response to the double patenting rejection of Paragraph 20 of the August 1, 2000 Office Action, rejecting the claims under the judicially created doctrine of double patenting over claims 1-15 of U.S. Patent 5,797,824, Applicant tenders herewith another terminal disclaimer. The undersigned sincerely hopes that this third terminal disclaimer will put to rest, once and for all, the continuing requests of the PTO for terminal disclaimers.

At pp. 7-8 of the August 2000 Office Action, the examiner puts forth a "Response to Arguments." Applicant respectfully traverses these responses of the examiner.

At Paragraphs 22-23, the examiner explains that Foreman is a 102(b) reference because the design application (07/93,681) does not "provide support for the material along the edge of the waistband being a soft padding member and Foreman was filed more than a year before the filing date of the 07/516,473 application..." Applicant agrees that that is an issue to be decided, apparently by the Board of Patent Appeals and Interferences. However, applicant also submits that Foreman, whether or not a §102(b) reference, does not render the previously-pending claims unpatentable under

either §102(a) or 103. The arguments for this have already been set forth. If the examiner concurs, as we hope, then a ruling by the Board would seem to become moot.

Applicant is adding numerous further claims to round out the scope of protection. Many of these claims do not specify that the material at the edge of the waistband must be a soft padding member. Accordingly, the deficiency which the examiner asserts in applicant's proof would not apply to these newly-added claims.

For example, claim 11 specifies that the disposable diaper has a plastic layer extending to and including a plastic edge at an edge of the diaper at a waistband, and the improvement comprises a horizontally oriented strip which is distinct from the top and bottom sheets, the strip being located at the waistband between the plastic edge and the wearer at a position to contact the skin of the wearer. The feature that this strip is at a position to contact the skin of the wearer distinguishes over the LUVS diaper which the Northern District of Illinois found to be prior art against applicant's '824 patent. That Proctor & Gamble diaper included an elastomeric strip that did not touch the skin of the wearer. Accordingly, new claim 11 cannot be rejected as anticipated by the Proctor & Gamble LUVS diaper. A transcript of the deposition of Proctor & Gamble is also attached hereto for review by the examiner. Indeed the examiner will note that Proctor & Gamble desired that the elastomeric strip not come into contact with the skin of the wearer. The examiner may note that the district court considered this issue with regard to the alleged invalidity of claim 15 of the '824 patent.

While the examiner may consider that Foreman discloses the features of claim 11, the examiner must also conclude that the subject matter of claim 11 was disclosed by the design patent application, as to which priority is asserted. Since Foreman was not published until March 28, 1989, it certainly cannot be a 102(b) reference against Claim 11 which is supported by the design patent application which bears a filing date of September 8, 1987. Additionally, it is noted that the filing date of Foreman is October 30, 1987 (which is several weeks after the filing date of Tracy's design patent application).

Additionally, it is noted that Foreman asserts that it is a continuation of a prior application Serial No. 917,475 filed October 10, 1986. However, the attention of the examiner is respectfully invited to the Declaration of Rhonda Tracy dated January 28, 1999 wherein she explains that she conceived her invention prior to October 10, 1986. Her disclosure document 166,418 was dated and notarized on September 2, 1986 - which is five weeks (approximately) before the October 10, 1986 asserted priority date of Foreman. Accordingly, since Foreman is not a 102(b) bar against claim 11, Tracy has the right to swear behind Foreman and has already done so. Consequently, the examiner is respectfully requested to allow claim 11.

Independent claim 21 has been added and presents a very similar issue. For the same reasons discussed with respect to claim 11, independent claim 21 should be allowed.

Independent claim 31 specifies the Tracy invention with respect to the leg hole. The examiner is respectfully requested to allow claim 31 for the same reasons as explained with regard to claim 11.

New dependent claims are based on new claims 11, 21, and 31. Many of these claims call for a padding member or cushion, and these present varying issues for resolution. Applicant submits that these claims should be allowed at least for the reason that they are based on allowable independent claims.

In Paragraph 24, the examiner invites applicant to file a supplement terminal disclaimer stating that (she) has 100% or the whole interest. Applicant is tendering such a supplemental terminal disclaimer.

In Paragraph 25, the examiner addresses applicant's argument that the PTO Board has not considered McConnell as it is now being applied. The applicant does not contend that the current claims are "the same" as those found in the applicant's earlier patent, and applicant asserts that it would be improper for the examiner to issue a §101 statutory rejection. The examiner is, however, respectfully requested to withdraw the rejections based on McConnell. The statements by the Board in the decision mailed September 29, 1997 discuss McConnell and its various deficiencies. While the

present claims are not exactly the same as the claims before the Board in 1997, the deficiencies of McConnell remain as deficiencies. Applicant is not prepared to withdraw the claims on the basis of the rejection based on McConnell and is prepared to place the issue before the Board once again for yet another ruling based on this deficient reference. However, the undersigned hopes that this will not be necessary.

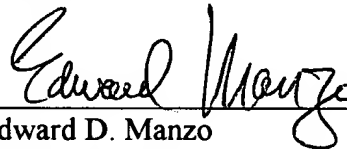
Applicant respectfully requests that all rejections be withdrawn, that the new claims be examined, and that all claims be passed to allowance. Any fee required for the new claims or the terminal disclaimer may be charged to the new deposit account of the undersigned firm. However, it is respectfully noted that the terminal disclaimer fee has once been paid and therefore should not be payable again.

Conclusion

Any further fee that is required may be charged to deposit account 50-1039.

Favorable consideration is earnestly solicited.

Respectfully submitted,



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enclosures

1. N.D. Illinois summary judgment ruling dated November 16, 2000
2. Tracy deposition of May 25, 2000 (and errata sheets)
3. Proctor & Gamble deposition